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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,472	01/31/2006	Mutsuhiro Ohmori	284083US6PCT	5687

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EXAMINER
JACOB, AJITH

ART UNIT	PAPER NUMBER
2161	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/566,472	OHMORI ET AL.
	Examiner	**Art Unit**	
	Ajith Jacob	2161	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 January 2006*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 January 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/06*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   The instant application having Application No. 10/566472 has a total of 26 claims

pending in the application, there are 8 independent claims and 18 dependent claims, all

of which are ready for examination by the examiner.

Oath/Declaration

2.   The applicant's oath/declaration has been reviewed by the examiner and is found

to conform to the requirements prescribed in **37 C.F.R. 1.63.**

Claim Objections

3.   Claim 9 is objected to because of the following informalities: the first letter in the

first word, 'the', should be capitalized. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1-11 and 15-23 are directed towards software, per se. The claims lack

the necessary physical articles or objects to constitute a machine or a manufacture

within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a

process nor are they a combination of chemical compounds to be a composition of

matter. As such, they fail to fall within a statutory category. They are, at best, functional

descriptive material *per se*. Descriptive material can be characterized as either

"functional descriptive material" or "nonfunctional descriptive material." Both types of

"descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33

F.3d at 1360, 31 USPQ2d at 1759. When <u>functional</u> descriptive material is recorded on

some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

5.   Claim 1 comprises of a device, but does not specify a physical piece of hardware to fulfill the claim, and thus has been rejected.

6.   Claims 2-11 does not solve any of the non-statutory deficiencies of claim 1, and thus are rejected for the reasons stated above.

7.   Claim 15 comprises of a device, but does not specify a physical piece of hardware to fulfill the claim, and thus has been rejected.

8.   Claims 16-23 does not solve any of the non-statutory deficiencies of claim 15, and thus are rejected for the reasons stated above.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10.   Claims 1-8 and 10-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill et al. (US 6,236,981 B1).

For claim 1, Hill et al. teaches:

An information processing device storing user information related to a user and communicating with a plurality of other information processing devices, said information processing device comprising:

presenting means for presenting user information to be read or changed by said other information processing device [payment token from user to merchant platform, column 2, lines 11-12];

specifying means for specifying permission to read or change the user information presented by said presenting means [user registration database for authentication of user, column 9, lines 28-32];

identifying means for identifying said other information processing device [user and merchant identification module, column 9, lines 44-55]; and

storing means for storing the user information read or changed by said other information processing device identified by said identifying means in association with said other information processing device [user registration database holding user information, column 9, lines 28-30].

For claim 2, Hill et al. teaches:

The information processing device as claimed in claim 1, further comprising communicating means for performing quasi-electrostatic field communication,

electromagnetic wave communication, optical communication, or electric

communication [payment over communication network, column 2, lines 46-51].

For claim 3, Hill et al. teaches:

The information processing device as claimed in claim 1, wherein

a device external to said information processing device is used as an input or output

interface [payment server separate to merchant platform, column 2, lines 5-6].

For claim 4, Hill et al. teaches:

The information processing device as claimed in claim 1, wherein

when an initial communication with said other information processing device is

performed, information for identifying said information processing device is transmitted

to said other information processing device [payment transaction system for validation,

column 2, lines 24-40].

For claim 5, Hill et al. teaches:

The information processing device as claimed in claim 1, wherein

when an initial communication with said other information processing device is

performed, a first code used by said information processing device to encrypt

information [random numbers, column 2, lines 5-6] and a second code generated in

correspondence with said first code are generated [digital payment token, column 2,

lines 7-10], and said first code is transmitted to said other information processing device

[issuance of digital token from random number, column 2, lines 7-10], and

a third code used by said other information processing device to encrypt information is

obtained via said communicating means [random number in payment server compared

for high level of cryptographic security, column 2, lines 24-40].

For claim 6, Hill et al. teaches:

The information processing device as claimed in claim 1, wherein

said user information is updated on a basis of a history of use of contents provided from

said other information processing device [payer module honors requests based on

history of previous transactions, column 13, lines 12-17].

For claim 7, Hill et al. teaches:

The information processing device as claimed in claim 1, wherein

a communication with an information managing device that manages said user

information is performed via a network, and said user information is updated so that

contents of the user information stored in said information processing device are

identical with contents of the user information stored in said information managing

device [carnet module supports interaction with merchant and payment service for user

information consistency, column 5, lines 25-30].

For claim 8, Hill et al. teaches:

The information processing device as claimed in claim 7, wherein

said information managing device identifies said other information processing device

permitted to read or change said user information, and provides said user information to

the other information processing device permitted to read or change said user

information via said network [Program called NetSumm to manage user tokens in

carnet, column 8, lines 18-55].

For claim 10, Hill et al. teaches:

The information processing device as claimed in claim 1, wherein

said user information has preference information indicating preferences of said user,

and said preference information is transmitted to an information device specified by said

user, and said information device is operated in correspondence with said preference

information [payer information based on user preference inputted by user, column 13,

lines 11-17].

For claim 11, Hill et al. teaches:

The information processing device as claimed in claim 1, wherein

new user information is created on a basis of a plurality of pieces of user information

associated with a plurality of other information processing devices [creator module adds

new user with multiple user information for payment and merchant platform, column 11,

lines 9-17].

Claim 12 is the method of claim 1. Hill et al. teaches the limitations of claim 1 for the

reasons stated above.

Claim 13 is the program on a device of claim 1. Hill et al. teaches the limitations of

claim 1 for the reasons stated above.

Claim 14 is the recording medium of claim 1. Hill et al. teaches the limitations of claim 1

for the reasons stated above.

For claim 15, Hill et al. teaches:

An information processing device for communicating with a plurality of other

information processing devices via a network and storing user information related to a

user, said information processing device comprising:

communicating means for communicating with a portable terminal possessed by the

user via said network [client platform via PDA, column 4, lines 38-44];

obtaining means for obtaining the user information stored in said portable terminal and

relating to said user [transfer information from user to merchant, column 4, lines 28-29];

updating means for updating said user information stored in said information processing

device on a basis of the user information obtained by said obtaining means [update on

payment server, column 4, lines 30-32]; and

generating means for generating data for updating said user information stored in said

portable terminal [updater module updates carnet information database, column 12,

lines 34-44].

For claim 16, Hill et al. teaches:

The information processing device as claimed in claim 15, wherein

when said portable terminal is not connected to said network, said communicating

means communicates with said other information processing device in place of said

portable terminal [if authorization refused, sent failure signal to payer module, column

12, lines 49-67].

For claim 17, Hill et al. teaches:

The information processing device as claimed in claim 16, wherein

further stored as said user information are: information for identifying said portable

terminal;

a password for said portable terminal to authenticate said other information processing

device [user registration database requiring password, column 9, lines 28-32];

a first code used by said portable terminal to encrypt information and a second code

generated in correspondence with the first code [random number database used to

construct payment tokens, column 10, lines 10-23];

information for identifying said other information processing device [authentication

token, column 10, lines 10-23];

a password for said other information processing device to authenticate said portable

terminal [ID taken to authenticate during collector module, column 12, lines 49-67]; and

a third code used by said other information processing device to encrypt information

[PIN identification at merchant module, column 13, lines 19-22].

For claim 18, Hill et al. teaches:

The information processing device as claimed in claim 15, further comprising

updating means for updating said user information on a basis of a history of use of

contents provided from said other information processing device [updating based on

previous transaction history, column 13, lines 12-17].

For claim 19, Hill et al. teaches:

The information processing device as claimed in claim 15, wherein

an access point connecting said portable terminal with said network is identified, a

present value of said user is determined on a basis of a position of the identified said

access point, and information on the present position of said user is stored as said user

information [location of client installation, column 7, lines 64-67 – column 8, lines 1-17].

For claim 20, Hill et al. teaches:

The information processing device as claimed in claim 19, wherein

an ID for identifying a device corresponding to said access point and an access key

necessary to communicate with said device is further stored as said user information

[identification provided, column 4, line 2].

For claim 21, Hill et al. teaches:

The information processing device as claimed in claim 20, wherein

said communicating means communicates with said portable terminal at predetermined

time intervals to update the information on the present position of said user, the ID for

identifying the device corresponding to said access point, and the access key [node

access in regular intervals, column 5, lines 6-24].

For claim 22, Hill et al. teaches:

The information processing device as claimed in claim 21, wherein

when a request signal indicating a request for conversation with said user is received

from said other information processing device via said network, said user information is

transmitted to said other information processing device [payment service request made

from client and issued, column 5, lines 31-51].

For claim 23, Hill et al. teaches:

The information processing device as claimed in claim 15, wherein

said user information exceeding a storage capacity of said portable terminal is further

stored [Merchant Information database also holds records along with carnet information

database, column 9, lines 44-67].

Claim 24 is the method of claim 1. Hill et al. teaches the limitations of claim 15 for the reasons stated above.

Claim 25 is the program on a device of claim 1. Hill et al. teaches the limitations of claim 15 for the reasons stated above.

Claim 26 is the recording medium of claim 1. Hill et al. teaches the limitations of claim 15 for the reasons stated above.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al. as set forth above against claim 1 above, and in view of Van Berkel et al. (US 2002/0190964 A1).

As per claim 1, Hill et al. teaches user identification [user and merchant identification module, column 9, lines 44-55], but does not teach electrostatic field from body of user for authentication.

Van Berkel et al. teaches quasi-electrostatic sensing with user's fingers for authentication [0009-0010].

Hill et al. (US 6,236,981 B1) and Van Berkel et al. (US 2002/0190964 A1) are analogous art because they are from the same field of endeavor of input devices and authentication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the user identification described by Hill et al. and add quasi-electrostatic sensing as described by Van Berkel et al.

The motivation for doing so would be to have "electric field sensing components that are less bulky than known types [0013].

Therefore, it would have been obvious to combine Hill et al. (US 6,236,981 B1) with Van Berkel et al. (US 2002/0190964 A1) for the benefit of providing more secure authentication.

Conclusion

The Examiner requests, in response to this Office action, that support be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the Examiner in prosecuting the application.

When responding to this Office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajith Jacob whose telephone number is 571-270-1763. The examiner can normally be reached on M-F 7:30-5:00 EST, Every other Friday off.
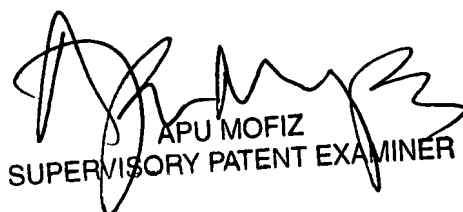
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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AJ

11/13/2007   AJ
                                                                              Patent Examiner

APU MOFIZ
SUPERVISORY PATENT EXAMINER